



PATENT  
Attorney Docket No. 041514-5130

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11.18.03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Masakazu OGASAWARA et al.

Application No.: 09/891,471

Filed: June 27, 2001

For: PICKUP DEVICE FOR RECORDING OR  
REPRODUCING INFORMATION TO  
AND FROM A MULTI-LAYERED  
RECORDING MEDIUM HAVING A  
PHOTODETECTOR WITH A  
NORMALIZED DETECTOR SIZE  
(AS AMENDED)

Confirmation No.: 1389

Group Art Unit: 2653

Examiner: A. Psitos

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**RESPONSE AND REQUEST FOR RECONSIDERATION**

In response to the Office Action dated June 13, 2003 (Paper No. 13), the period for response to which extends through November 13, 2003 by the concurrent filing of a request for two-month extension of time and corresponding fee payment, favorable reconsideration and allowance of the subject application are respectfully requested in view of the following remarks.

**Summary of the Office Action**

Claims 1 and 6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Hayashi et al.* (U.S. Patent No. 6,278,670) with the allegedly acknowledged "normalized"

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methodology in the "STANDARD DVD BOOK" and further in view of *Kasami et al.* (U.S. Patent No. 6,312,780).

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the art as applied to claim 1 and further in view of Official Notice.

#### **Summary of the Response to the Office Action**

No changes to the claims have been made by this response. Accordingly, claims 1, 6 and 7 remain currently pending for consideration.

#### **Interview with the Examiner**

As an initial matter, Applicants would like to thank the Examiner for the courtesies extended during the personal interview with Applicants' undersigned representative on October 14, 2003.

#### **Information Provided in Response to the Examiner's Request**

The Final Office Action dated December 5, 2002 requested the information in the "STANDARD DVD BOOK" to complete the search report. In the Amendment filed on April 4, 2003, Applicants filed Exhibit A, which is pages 6-7 of Standard ECMA-267, having the information requested by the Final Office Action. Applicants also explained in the April 4, 2003 Amendment that the "STANDARD DVD BOOK" can not be provided due to a contractual agreement with the DVD Forum. Because the Examiner has not made an additional request for the "STANDARD DVD BOOK" since the December 5, 2002 Final Office Action, Applicants presume that Exhibit A satisfies the December 5, 2002 Final Office Action's request for the information in the "STANDARD DVD BOOK" to complete the search report. If Applicants' ✓

understanding is incorrect, it is respectfully requested that the Examiner contact Applicants' undersigned representative.

**Claim Rejections Under 35 U.S.C. §103(a)**

**Claims 1 and 6**

Claims 1 and 6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Hayashi et al.* with the allegedly acknowledged “normalized” methodology in the “STANDARD DVD BOOK” and further in view of *Kasami et al.* This rejection is respectfully traversed for at least the following reasons.

1. The Office Action applies the “STANDARD DVD BOOK” under 35 U.S.C. §103(a) and cites *In re Nomiya*, 509 F.2d 566, 184 U.S.P.Q. 607 as allegedly providing basis for applying the “STANDARD DVD BOOK” as prior art against the present application. *In re Nomiya* relates to a situation involving a patent application containing Figs. 1 and 2 labeled as prior art, and associated statements made by the appellants during prosecution. The court found that the appellants had conceded that the structure shown in Figs. 1 and 2 was prior art by labeling Figs. 1 and 2 as such. See *id.* at 571. In particular, the court in *In re Nomiya* emphasizes that “[i]t is necessary to consider **everything appellant [i.e., applicants] have said about what is prior art to determine the exact scope of their admission** (emphasis added).” 509 F.2d 566, 571.

In contrast to the facts in *In re Nomiya*, no portion of the specification and the responses, including figure 8 of the present application, refers to the “STANDARD DVD BOOK” as prior art. Thus, Applicants respectfully submit that no admission of the “STANDARD DVD BOOK” has been made that it is prior art. Further, there is no admission that the “STANDARD DVD BOOK” was “the standard,” at the time of the invention was made by the Applicants.

Accordingly, Applicants respectfully submit that the decision of *In re Nomiya* is not applicable to facts associated with the present application and that the “STANDARD DVD BOOK” should not be considered as prior art against the present application based on *In re Nomiya*.

Applicants also respectfully submit that the “STANDARD DVD BOOK” is not a publicly available document. Thus, it is respectfully submitted that the “STANDARD DVD BOOK” is not known by others. Accordingly, Applicants respectfully assert that the “STANDARD DVD BOOK” is not prior art under any section of 35 U.S.C. §102. If the Examiner continues to apply the “STANDARD DVD BOOK” as prior art, further support for such an assertion under 35 U.S.C. §102 is respectfully requested.

2. The Office Action asserts that “Hayashi et al document describes...a minimum size of light spots, which fall within the range claimed.” See page 3, lines 10-11 of the Office Action. Applicants respectfully submit that no portion of *Hayashi et al.*’s disclosure discusses the relationship between an actual photodetector light receiving surface area and detecting optical system magnification as set forth in Applicants’ claimed invention. Further, the spot size of 20 to 50  $\mu\text{m}$  in *Hayashi et al.* is a diameter rather than a ratio given in  $\mu\text{m}^2$  relating to the actual photodetector light receiving surface area and detecting optical system magnification. Accordingly, Applicants respectfully submit that *Hayashi et al.* fails to teach or suggest the claimed combination as set forth in independent claim 1 including at least “wherein said photodetector has a normalized detector size ( $B/\beta^2$ ) of a size of 10  $\mu\text{m}^2$  to 50  $\mu\text{m}^2$ ,” and “wherein the normalized detector size ( $B/\beta^2$ ) is given by an equation of  $B/\beta^2 = L^2 / (f_c/f_{OB})^2$  wherein L denotes a size of one side of the photodetector,  $f_c$  denotes a focal distance of the detecting optical system and  $f_{OB}$  denotes a focal distance of the objective lens.”

3. The Office Action interprets the feature “a normalized detector size ( $B/\beta^2$ ) of a size of  $10\ \mu\text{m}^2$  to  $50\ \mu\text{m}^2$ ,” as set forth in independent claim 1 to be a narrowing of the range between  $100\ \mu\text{m}^2$  to  $144\ \mu\text{m}^2$  mentioned in the “STANDARD DVD BOOK.” See page 4, line 7-8 of the Office Action. In particular, the Office Action relies upon *In re Peterson*, 315 F.3d 1325, 65 U.S.P.Q. 2d 1379 as allegedly providing basis for rejecting Applicants’ arguments in this regard. *In re Peterson* relates to a situation involving a patent application containing overlapping elements with a cited reference and claiming narrower ranges of the overlapped elements in comparison with the cited reference. In particular, the court found that a *prima facie* case of obviousness was made because selecting a narrow range from within a somewhat broader range disclosed in a prior art reference is no less obvious than identifying a range that simply overlaps a disclosed range. See id. at 1329-1330.

In contrast to *In re Peterson*, the claimed combination, as set forth in independent claim 1, includes a range of a normalized detector size that does not overlap the range in the “STANDARD DVD BOOK.” That is, a range of  $10\ \mu\text{m}^2$  to  $50\ \mu\text{m}^2$  does not overlap a range of  $100\ \mu\text{m}^2$  to  $144\ \mu\text{m}^2$ . Accordingly, Applicants respectfully submit that the decision of *In re Peterson* is not applicable to facts associated with the present application. If the Examiner continues to apply *In re Peterson*, Applicants respectfully request further support for such an assertion.

4. Applicants respectfully submit that neither *Hayashi et al.* nor *Kasami et al.* teach or suggest, either separately or combined, a normalized detector size. The “STANDARD DVD BOOK” does not teach a normalized detector size within  $10\ \mu\text{m}^2$  to  $50\ \mu\text{m}^2$ , as recited in claim 1. In contrast to Applicants’ claimed combination, the “STANDARD DVD BOOK” discloses a

range of  $100\ \mu\text{m}^2$  to  $144\ \mu\text{m}^2$ . Accordingly, Applicants respectfully submit that *Hayashi et al.*, the “STANDARD DVD BOOK,” and *Kasami et al.*, whether taken singly or in combination, fail to teach or suggest the claimed combination as set forth in claim 1 including at least “wherein said photodetector has a normalized detector size ( $B/\beta^2$ ) of a size of  $10\ \mu\text{m}^2$  to  $50\ \mu\text{m}^2$ ,” and “wherein the normalized detector size ( $B/\beta^2$ ) is given by an equation of  $B/\beta^2 = L^2 / (f_c/f_{OB})^2$  wherein L denotes a size of one side of the photodetector,  $f_c$  denotes a focal distance of the detecting optical system and  $f_{OB}$  denotes a focal distance of the objective lens.” In view of the above, *Hayashi et al.*, the “STANDARD DVD BOOK,” and *Kasami et al.*, whether taken separately or in combination, fail to teach or suggest each and every element set forth in claim 1, it is respectfully submitted that *Hayashi et al.* with the allegedly acknowledged “normalized” methodology in the “STANDARD DVD BOOK” and further in view of *Kasami et al.* do not render claim 1 unpatentable. Since claim 6 depends from claim 1, it is respectfully submitted that the applied references also do not render claim 6 unpatentable. Accordingly, withdrawal of the rejection of claims 1 and 6 under 35 U.S.C. §103(a) is respectfully requested.

#### Claim 7

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the art as applied to claim 1 and further in view of Official Notice. This rejection is respectfully traversed for at least the following reasons.

Applicants respectfully submit that at least because claim 7 depends from claim 1 and for the reasons mentioned above, *Hayashi et al.* with the allegedly acknowledged “normalized” methodology in the “STANDARD DVD BOOK” and further in view of *Kasami et al.* does not render claim 7 unpatentable.

In addition, the Office Action appears to assert that the existence of a detection circuitry, as set forth in claim 7, is old and well known and an official notice is taken thereof. Applicant respectfully traverses the Office Action's assertion and official notice, and requests that evidence be provided in accordance with M.P.E.P. §2144.03.

Accordingly, withdrawal of the rejection of claim 7 under 35 U.S.C. §103(a) is respectfully requested.


**Conclusion**

In view of the foregoing, withdrawal of the rejections and allowance of the pending claims are earnestly solicited. Should there remain any questions or comments regarding this response or the application in general, the Examiner is urged to contact the undersigned at the number listed below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,  
**MORGAN, LEWIS & BOCKIUS LLP**

Dated: October 31, 2003

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